

Appl. No. 09/509,603  
 Atty. Docket No. 6873  
 Amdt. dated 12/4/2003  
 Reply to Office Action of 9/9/2003  
 Customer No. 27752

#### REMARKS

Claims 1-10, 37-47, 48 and 50 are cancelled, and Claims 11-30 and 32 are withdrawn from consideration, all without prejudice to Applicants' right to file continuation applications relating thereto. Claims 31, 33, 34, 35, 36, 49 and 51 are in the case.

Claim 31 has been amended to recite the presence and amount of hydrophilic shear thinning polymer. Claim 33 has been amended to recite a Maukush group of polymers, and amounts thereof, present in the detergent composition used in the claimed process. Basis for these amendments appears at page 2, fourth full paragraph, and at page 3, first full paragraph. Claims 49 and 51 have been amended to recite the volatile alkanolamine as 2-amino-2-methylpropanol. Basis is at page 9, lines 6-9. Claims 31 and 33 have also been amended to recite the low level of surfactant used in the composition. Basis is at page 6, third line from the bottom. It is submitted that these amendments add no new matter, and entry is requested.

#### Rejections Under 35 USC 103

The claims previously indicated as allowable now stand rejected.

Claims 31, 33-37, 39, 42, 45, 49 and 51 stand rejected over EPO 0503219A1 ('219) and U.S. 5,538,664 and U.S. 5,638,569, for reasons of record at pages 2-5 of the Office Action.

Claims 40, 41, 43, 44, 46 and 47 stand rejected over EPO 0503219 and U.S. 5,538,664 and U.S. 5,638,569 and U.K. 1,357,323, for reasons of record at pages 5-6 of the Office Action.

Applicants respectfully traverse all rejections, to the extent they may apply to the amended claims now presented in the case.

At the outset, attention is directed to the disclosure at page 6, last paragraph. There, Applicants discuss the problem of superabsorbent overload that occurs with cleaning compositions that contain too high a level of surfactant. Accordingly, the claims herein specify that the claimed kit and process employ detergent compositions which contain limited, low amounts of surfactant.

It is submitted that this aspect of the present invention is wholly unrecognized in any of the cited documents, taken singly or in combination. As is clear from case law cited at MPEP 2141.02, "[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified." This is part of the "subject matter as a whole" test under 35 USC 103.

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Moreover, it is basic patent law that a prior art reference under §103 must teach or suggest all the claim limitations, with a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F. 2d 488, U.S.P.Q. 2d 1438 (Fed Cir. 1991). It is submitted that none of the references, taken singly or in combination, teaches or suggests the aforesaid problem/solution. It is respectfully submitted that these factors must be taken into consideration when applying the cited documents under §103.

It is submitted that, while U.S. '664 teaches the use of alkanolamines in hard surface cleaners (Abstract), it does not teach or suggest the use of the polymers herein to aid spreading and minimize filming/streaking (present specification, page 4, last paragraph). Nor does '664 teach or suggest the use of pads with superabsorbents, nor suggest the need to control the level of surfactant relating to such use.

It is also submitted that, while U.S. '569 teaches the use of superabsorbents in mops, (Col. 11, 1. 1), it neither teaches nor suggests anything relevant to the compositions herein, for use with such mops.

It is further submitted that, while '219 teaches alkanolamines in hard surface cleaners (Abstract), it does not suggest their use with the polymers herein, nor with superabsorbent pads, which, as noted, requires controlled (low) use of surfactants.

In light of the foregoing analysis, it is Applicants' overall position that the rejections of the subject matter of any of the currently-amended or former Claims 31, 33-37, 39, 42, 45, 49, and 51 over the cited documents constitutes an impermissible hindsight reconstruction of the present invention. In that regard, attention is directed to *In re Dembiczak*, 175 F. 3d 994, 50 USPQ 2d 1614 (Fed. Cir. 1999). In that case, the Federal Circuit emphasized the principle that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of the teaching or motivation to combine or otherwise modify prior art references.

Furthermore, as stated in *In re Shuman* 361 F. 2d 1008, 1012, 150 USPQ 54, 57 (CCPA, 1966);

It is impermissible to first ascertain factually what appellants *did* and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellant's invention from such prior art.

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As also noted in *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F. 2d 1572, 1577 & n. 14, 221 USPQ 929, 933 & n. 14 (F. Cir. 1984), when [as in the instant case] prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. [Cited in *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (CAFC, 1985)]

In view of the foregoing, reconsideration and withdrawal of these rejections are requested.

It is Applicants' overall position that the rejections of the subject matter of any of the currently-amended or former Claims 40, 41, 43, 44, 46 and 47 also constitute an impermissible hindsight reconstruction of the present invention.

The foregoing comments and controlling case law regarding '219, '664 and '569 continue to apply to this grounds of rejection, but will not be repeated here, for the sake of brevity.

The Examiner has additionally introduced U.K. '323 with the foregoing documents in order to cite the use of "the specific polymer, and the claimed concentration."

It is again respectfully submitted that this constitutes no more than a mosaic reconstruction by picking and choosing isolated elements from various references to arrive at the present invention. Citing references which merely indicate that isolated elements and/or features recited in the claims are known is not sufficient basis for concluding that the combination of claimed elements would have been obvious. *Ex parte Hiyamizu*, 10 USPQ 2d. 1393, 1394 (BPAI, 1988) Again, it is urged that this is particularly true in the instant case, where Applicants' recognition of the problem of high surfactant levels used with a superabsorbent material is nowhere suggested in the cited documents.

U.K. '323 teaches the use of hydrocolloids in hard surface cleaners. However, '323 teaches the use of alkaline inorganic salts in the compositions (Col. 2, l. 69) and does not suggest the use of volatile alkanolamines to adjust pH.

Importantly, '323 neither teaches or suggests the use of pads comprising superabsorbers with the disclosed compositions. Accordingly, the '323 levels of surfactants (0.5% to 10%) are outside the range now discovered to be important for proper functioning of the pads.

Overall Summary: U.K. '323 teaches polymers of the present type, but neither surfactants in the amounts employed herein, nor the use of alkanolamines, nor the use of superabsorbent pads. U.S. '664 teaches compositions with alkanolamines, but without the polymers used herein, nor the pads. U.S. '569 teaches superabsorbers, but not the low-surfactant/polymer/alkanolamine compositions herein, designed specifically for use with superabsorbent pads. EP '219 teaches alkanolamines, but

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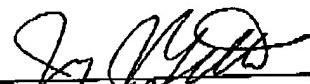
not polymers or pads of the present type. In light of the foregoing amendments, remarks and controlling case law, reconsideration and withdrawal of the rejections on this basis are requested.

In view of the foregoing, early and favorable action in the case is requested.

Respectfully submitted,

Policicchio et al.

By \_\_\_\_\_

  
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